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In re Application of :
MILLIS, et al. :
Application No.: 10/542,167 : DECISION ON PETITION
PCT No.: PCT/US04/00841 :
Int. Filing Date: 13 January 2004 : UNDER 37 CFR 1.181
Priority Date: 13 January 2003 :
Attorney Docket No.: 6682-67637-02 :
For: METHOD OF MAKING INDUSTRIAL :
CHEMICALS :
:

This decision is in response to applicant's "Response to Notification of Abandonment" filed 31 August 2006 in the United States Patent and Trademark Office (USPTO). The communication is being treated as a petition under 37 CFR 1.181. No petition fee is required.

BACKGROUND

On 13 January 2001, applicant filed international application PCT/US04/00841, which claimed priority of an earlier application filed 13 January 2003. The deadline for payment of the basic national fee in the United States was to expire 30 months from the priority date, 13 July 2005.

On 12 July 2005, applicant filed a transmittal letter for entry into the national stage in the United States, which was accompanied by the requisite basic national fee as required by 35 U.S.C. 371(c)(1).

On 27 December 2005, applicant was mailed a NOTIFICATION OF MISSING REQUIREMENTS UNDER 35 U.S.C. 371 (Form PCT/DO/EO/905) informing applicant of the need to provide an executed oath or declaration of the inventors, in compliance with 37 CFR 1.497(a) and (b), identifying the application by the International Application number and international filing date. Applicant was given two months to respond and advised that this time period could be extended with a proper petition and payment of fees.

On 07 August 2006, applicant was mailed a NOTIFICATION OF ABANDONMENT (Form PCT/DO/EO/909) informing applicant that applicant had failed to respond to the Form PCT/DO/EO/905 mailed 27 December 2005 within the time period set therein and that above-identified application was abandoned as to the United States.

On 30 August 2004, applicant filed the present petition under 37 CFR 1.181 requesting withdrawal of the abandonment arguing that a timely response to the Form PCT/DO/EO/905 had been filed.

DISCUSSION

The best evidence of what was actually received by the Office is a postcard receipt containing a specific itemization of all the items being submitted. See MPEP 503. Here, applicant has provided a copy of the date-stamped postcard receipt. The postcard identifies the application by applicant, serial number, title and docket number. Among the items listed on the receipt is Executed Declaration (5 pgs.)." The receipt is stamped "IAP7 Rec'd PCT/PTO 28 FEB 2006." Thus, it is clear that applicant filed an executed declaration of the inventors on 28 February 2006. Applicant has stated that the current copies provided are a true and complete copy of the papers previously filed. The filed transmittal letter shows a certification under 37 CFR 1.8 that the papers were deposited for mailing on 24 February 2006 and therefore are considered timely filed. As such, it is proper to grant applicant's petition to withdraw the holding of abandonment at this time.

It is noted that an examination of the filed combined declaration and power of attorney finds that the document does not comply with 37 CFR 1.497(a)-(b). The Manual of Patent Examination Procedure (MPEP) states at section 201.03: "An oath or declaration under 37 CFR 1.63 by each actual inventor must be presented. While each inventor need not execute the same oath or declaration, each oath or declaration executed by an inventor must contain a complete listing of all inventors so as to clearly indicate what each inventor believes to be the appropriate inventive entity. Where individual declarations are executed, they must be submitted as individual declarations rather than combined into one declaration." The filed declaration contains three signature pages "2" listing and signed individually by inventors MILLIS, TUPY and ABRAHAM. It appears that the filed declaration was assembled from numerous declarations or the inventors only returned the signature pages, either alternative renders the declaration non-compliant.

CONCLUSION

Applicant's petition under 37 CFR 1.181 is **GRANTED**.

The NOTIFICATION OF ABANDONMENT mailed 07 August 2006 is hereby
VACATED.

This application is being returned to the DO/EO/US for processing in accordance with this decision; specifically, the mailing of a "NOTIFICATION OF DEFECTIVE RESPONSE" (Form PCT/DO/EO/916) indicating that a compliant oath or declaration of the inventors is still required.



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